

REMARKS

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-31 are presently pending. Claims amended herein are none. Claims cancelled herein are none. New claims added herein are
5 none.

Herein, the "Action" or "Office Action" or "Office" refers to the Office Action dated February 27, 2003.

Prior Art Status of References

Applicant does not explicitly or implicitly admit that any reference is prior art. Nothing in this communication should be considered an acknowledgement, acceptance, or admission that any reference is considered prior art.
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Drawing Informalities

According the form PTO-948, the Draftsperson has objected to the drawings under 37 CFR 1.84 or 1.152 because the left margins for Figs. 1 and 4
15 are not acceptable.

In accordance with 37 CFR 1.85, Applicant will submit corrected drawings as a separate paper to the Official Draftsperson.

Reserving Right to file a §131 Declaration

Applicant expressly reserves the right to file a §131 declaration with
20 respect to Lennert et al.

Substantive Claim Rejections

Claim Rejections under §102 and §103

The Office rejects all pending claims under §102 and §103. For the reasons
5 set forth below, the Office has not made out a *prima facie* case of anticipation (i.e.,
§102). Likewise, for the reasons set forth below, the Office has not made out a
prima facie case of obviousness (i.e., §103). Accordingly, Applicant respectfully
requests that the rejections be withdrawn and the case be passed along to issuance.

The Office's rejections are based upon one or more of the following
10 references:

- **Lannert:** *Lannert et al.*, US Patent No. 6,169,994;
- **Marron:** *Marron*, US Patent No. 5,359,730.

Anticipation Rejections

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The §102 (Anticipation) Standard

In making out a §102 rejection, the Federal Circuit has stated that a reference anticipates a claim if it discloses every element of the claim. See Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir.
20 1991); Richard v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Thus, anticipation is determined by “identify[ing] the elements of the claims, determin[ing] their meaning in light of the specification and prosecution history, and identify[ing] corresponding elements disclosed in the allegedly

anticipating reference.” Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Consequently, if any claimed element is missing from the allegedly anticipating reference, then anticipation is negated. Kloster Speedsteel AB v. Crucible Inc., 793 F.3d 1565, 1571 (Fed. Cir. 1987). Close is not enough. Every element in the claim must exist in the allegedly anticipating reference for the §102 rejection to stand.

Based upon Lannert

10 The Office rejects claims 1-3, 6-7, 10-11, 14-15, 17-19, 22-27, and 30-31 under 35 USC § 102(e) as being anticipated by Lennert. Applicant traverses this rejection.

Claims 1, 11, 17, 24, and 25

15 The Office indicates that Lannert discloses the preamble of these claims (e.g., “a program-module update system” for claim 1). Applicant submits that Lannert does not disclose this. Instead, Lannert discloses a system for updating “configuration data” when hardware or software is updated.

So, instead of a system for updating “program modules” (as indicated in claim 1), Lannert discloses a system for updating “configuration data.” Lannert
20 updates data—not program modules.

The following quotes from the Abstract of Lannert are provided as example evidence of Applicant’s position (emphasis has been added):

- “This invention [of Lannert] uses a computer program to mine preexisting hardware equipment *configuration data* located in a

variety of preexisting source hardware equipment *configuration databases.*” (First sentence of the Abstract)

- “The computer program [of Lennert] either creates a new hardware equipment *configuration database* from parts of existing hardware equipment *configuration databases* or modifies an existing hardware equipment *configuration database.*” (Second sentence of the Abstract)

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So, instead of updating a program module (as is recited in these claims), Lennert discloses a system to update configuration data and configuration databases.

On page 8 of the Application, Applicant describes a program module as being a “section of computer-executable instructions.” Applicant submits that configuration data is *data* and as such, it is not computer-executable instructions. Therefore, *configuration data* is not a *program module*.

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The Office indicates that Lennert discloses, “determination unit for determining whether a hardware-specific program module is an updated program module” (which is quoted from claim 1). The Office refers to col. 9, lines 20-40 for support. Applicant submits that Lennert does not disclose this.

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First, the determination unit (as claimed by Applicant) operates on program modules. As discussed above, Lennert operates on configuration data and databases. Again, such data is not a program module.

Second, the determination unit (as claimed by Applicant) makes its determination based upon a “hardware-specific program module.” On page 8 of the Application, Applicant describes a hardware-specific program module as being

“a program module that is associated with a specific hardware device and it is generally intended to facilitate computer interaction with such device.”

While Lennert does appear to discuss hardware-specific *data* (e.g., item 66 in Fig. 3), it does not disclose or teach hardware-specific *program modules*.

5 Therefore, this hardware-specific data is configuration data and not a “section of computer-executable instructions” that is “associated with a specific hardware device.”

The Office indicates that Lennert discloses, “a source-redirection unit for specifying a source locus for a program module determined to be an updated 10 program module by the determination unit” (which is quoted from claim 1). The Office refers to col. 9, lines 12-41 for support. Applicant submits that Lennert does not disclose this.

Since Lennert operates on data and databases rather than on program modules (as the claims do), then Lennert does not specify a new source locus for 15 program modules.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

Claims 2 and 18

20 These claims are dependent upon a base claim (e.g., claim 1 or 17) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its 25 rejections.

Claims 3, 19, and 27

These claims are dependent upon a base claim (e.g., claim 1, 17, or 26) and are allowable as depending from an allowable base claim. These claims are also
5 allowable for their own recited features which, in combination with those recited their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

10 Claims 6, 14, 22, 30

These claims are dependent upon a base claim (e.g., claim 1, 10, 17, or 26) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited their base claim, are neither disclosed nor suggested by the references of
15 record.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

Claims 7 and 15

20 These claims are dependent upon a base claim (e.g., claim 1 or 10) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its
25 rejections.

Claim 10

This independent claim is allowable for many of the reasons given above in the discussion of claim 1. In particular, Lannert does not disclose a source-redirection unit or a program-module copier that operates on “program modules.”
5 Lannert’s operations are focused on configuration data and databases, not program modules.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

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Claims 23 and 31

These claims are dependent upon a base claim (e.g., claim 17 or 26) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited
15 their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

Claim 26

20 This independent claim is allowable for many of the reasons given above in the discussion of claim 1. In particular, Lannert does not disclose operations on “program modules.” Lannert’s operations are focused on configuration data and databases, not program modules.

According to the above reasons, Applicant asks the Office to withdraw its
25 rejections.

The § 103 Standard

To establish a prima facie case of obviousness, Applicant understands that there are at least three basic criteria that *must* be met and that the Office has the
5 burden to show that these criteria are met. Those three criteria include:

- There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 10 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).
- There must be a reasonable expectation of success of the combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
- The cited references must teach or suggest all of the claim limitations. 15 *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1439 (Fed. Cir. 1991).

20 Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.¹

¹ See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.²

The need for specificity pervades this authority.³

5 A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art *teaches away* from the claimed combination. A reference is said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

10 In addition, the references must either be in the field of the inventor's endeavor, or reasonably pertinent to the specific problem with which the inventor was involved. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). Put another way, the references must be in an art *analogous* to that of the invention.

Graham factors). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

² See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") (quoting *In Re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

³ See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The Office Has Not Made Out a Case of Prima Facie Obviousness

Applicant disagrees with the Office's obviousness rejections and respectfully submits that the Office has not made out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of these
5 rejections.

Based upon Lannert & Official Notice

The Office rejects claims 4-5, 12-13, 20-21, and 28-29 under 35 USC § 103(a) as being unpatentable over Lannert in view of Official Notices. Applicant
10 traverses this rejection.

Claims 4, 12, 20, 28

These claims are dependent upon a base claim (e.g., claim 1, 10, 17, or 26) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those
15 recited their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

20 **Claims 5, 13, 21, and 29**

These claims are dependent upon a base claim (e.g., claim 1, 10, 17, or 26) and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those
25 recited their base claim, are neither disclosed nor suggested by the references of record.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

Based upon Lannert and Marron

5 The Office rejects claims 8, 9, and 16 under 35 USC § 103(a) as being unpatentable over Lannert in view of Marron. Applicant traverses this rejection.

Claims 8, 9, and 16

These claims are dependent upon a base claim (e.g., claim 1, or 10) and are allowable as depending from an allowable base claim. These claims are also 10 allowable for their own recited features which, in combination with those recited their base claim, are neither disclosed nor suggested by the references of record.

Furthermore, Applicant submits that there is no suggestion, or motivation found in either Lannert or Marron to encourage one of ordinary skill in the art to combine their teachings. Lannert is focused on updating configuration data for 15 telephone switching equipment. Such equipment does not appear to have an operating system. However, Marron is focused on computing systems (such as mainframe computers) and their operating systems.

According to the above reasons, Applicant asks the Office to withdraw its rejections.

Dependent Claims

In addition to other possible reasons, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is
5 allowable.

Conclusion

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Office is urged to contact the
10 undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

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AMENDMENTS

Amendments in Marked-up Form:

Amendments hereafter are in *Marked-up Form* (i.e., with markings to indicate the
5 changes that have been made). Specification is amended in accordance with 37
CFR §1.121(b) and claim(s) are amended in accordance with 37 CFR §1.121(c).

Specification Amendment Summary

Please replace the entire paragraph starting at line 7 on page 8 with the
10 following paragraph:

Described herein are exemplary implementations of the
program-module updater (i.e., “exemplary program-module
updater”). A program module is a generic term for ~~any~~ a section of
15 computer-executable instructions. A hardware-specific program
module is a generic label for a program module that is associated
with a specific hardware device and it is generally intended to
facilitate computer interaction with such device. An example of
such a hardware-specific program modules is a device driver.

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